

### **REMARKS**

By this Amendment, Applicants amend claims 1, 3, and 5 to more appropriately define the present invention. Applicants also cancel claims 2 and 6-20 without prejudice or disclaimer of the subject matter thereof, and add new claims 21-26 to address other aspects of the present invention. Upon entry of this Amendment, claims 1 and 3-5 and 21-26 will be pending.

In the Final Office Action mailed October 19, 2004, the Examiner rejected claims 1-5 under 35 U.S.C. § 101; rejected claims 3-5 under 35 U.S.C. § 112, second paragraph; rejected claims 1-4 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,684,965 to Pickering (hereinafter "Pickering") in view of Applicant's admitted prior art; and rejected claims 1, 3, and 5 under 35 U.S.C. § 103(a) as unpatentable over Pickering as applied to claims 1-4, and further in view of U.S. Patent No. 5,465,206 to Hilt et al. (hereinafter "Hilt"). Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. § 101, 112, and 103.

#### **Regarding Claim Rejections under 35 U.S.C. § 101**

Applicants respectfully traverse the Examiner's rejection of claims 1-5 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. Contrary to the Examiner's assertions, the "retrieving and presenting" step does reference a computer implementation. For example, claim 1 recites a combination including, "executing a single instance of a bill presentment and payment application," and "using the single instance of the bill presentment and payment application." Because "the single instance of the bill presentment and payment application" is associated with computer software and the claim performs process steps associated with the "application," the claim does achieve a useful, tangible result, and is thus statutory. However, to expedite the

prosecution of this case, Applicants have amended claim 1 to recite “a computer implemented billing method.” Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-5 under 35 U.S.C. § 101.

**Regarding Claim Rejections under 35 U.S.C. § 112, second paragraph**

Applicants respectfully traverse the Examiner’s rejection of claims 3-5 under 35 U.S.C. § 112, second paragraph. A claim is allowable if the claim defines the patentable subject matter “with a reasonable degree of particularity and distinctness,” “[s]ome latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.” M.P.E.P. § 2173.02. Applicants submit claim 3 meets this criteria.

In response to the Examiner’s question, Applicants respectfully submit that the claim language would cover either situation noted by the Examiner, as well as others. For example, those skilled in the art recognize that display templates, such as HTML templates, used in Internet or World Wide Web applications may contain display information indicating display characteristics (e.g., metadata). In other applications, display templates may include other information associated with application specific displaying methods. In an attempt to expedite prosecution, however, Applicants have amended claim 3 to indicate the detailed billing data is displayed to the customer by the populated templates. As such, Applicants respectfully request withdrawal of the rejection of claims 3-5 under 35 U.S.C. § 112, second paragraph.

**Regarding Claim Rejections under 35 U.S.C. § 103**

Applicants respectfully traverse the Examiner’s rejection of claims 1-4 under 35 U.S.C. § 103(a) as unpatentable over Pickering in view of Applicants’ admitted prior

art. In order to establish a prima facie case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143, emphasis added.

The Examiner's rejection of claims 1-4 has not met this criteria because the cited art fails to teach or suggest the recitations of these claims. For instance, Pickering fails to teach or suggest at least "receiving in a computer an electronic billing request from a customer without identifying any billing entities," as asserted by the Examiner. Instead, Pickering discloses a consolidated billing system having a customer enrolling process. "If a customer is interested in participating in the program, the customer contacts the financial firm (usually by telephone) and provides information regarding which company or utility bills should be included, as well as personal information such as name, address and social security number." Pickering, column 3, lines 58-63, emphasis added. However, Pickering's teaching of the customer enrollment does not constitute a teaching of "receiving in a computer an electronic billing request from a customer without identifying billing entities," as required by amended claim 1.

Moreover, Applicants traverse the Examiner's position that Applicants' discussion in the background section of the specification constitutes "prior art." Indeed, the mere discussion of IBPP systems that "permit customers to view, store, and even pay bills using a Web browser, e-mail, or personal financial management software" (specification, page 2) does not teach or even suggest "receiving in a computer an

electronic billing request from a customer without identifying billing entities,” as recited by amended claim 1.

Further, the Examiner argues that step 21 of Pickering is “executing a single instance of a bill presentment and payment application (step 21).” (Office Action at 3.) However, in Pickering, step 21 is merely generating “a single customer billing statement.” Pickering, column 4, lines 41-42. A mere teaching of a single customer billing statement does not constitute “executing a single instance of a bill presentment and payment application,” as recited by claim 1.

Therefore, neither Pickering, nor general knowledge of IBPP systems, taken alone or in any reasonable combination, teaches or suggests all claim elements recited in claim 1. As such, a prima facie case of obviousness has not been established by the Examiner. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 1 and timely allowance of this claim.

Because claim 2 has been canceled, the rejection of claim 2 is therefore moot. Claims 3 and 4 depend from claim 1. As explained, claim 1 is distinguishable from the cited art. As such, claims 3 and 4 are also distinguishable from the cited art for at least the same reasons set forth in connection with claim 1. Further, the cited art does not teach or suggest retrieving a customized display template associated with each of the plurality of billing entities. Instead, the billing information for multiple billing entities taught by Pickering is configured by the consolidated billing system. Therefore, Applicants request the rejection of claims 3 and 4 be withdrawn and the claims allowed.

Applicants also respectfully traverse the Examiner’s rejection of claims 1, 3, and 5 under 35 U.S.C. § 103(a) as unpatentable over Pickering as applied to claims 1-4,

and further in view of Hilt. As explained above, Pickering and general knowledge of IBPP systems fail to teach or suggest at least “receiving in a computer an electronic billing request from a customer without identifying billing entities,” as asserted by the Examiner.

Hilt fails to cure the deficiencies. Hilt teaches an electronic bill pay system through which a consumer could pay a biller through the consumer’s bank. See Hilt, abstract. In Hilt, after a consumer receives a bill directly from a biller, the consumer could authorize a remittance from the consumer’s bank. To do that, the “consumer transmits to its bank a bill pay order indicating . . . the biller’s biller identification number,” and the bank then forwards the payment “to the biller’s bank.” Hilt, abstract. However, Hilt’s teaching on the electronic bill pay system does not constitute a teaching of “receiving in a computer an electronic billing request from a customer without identifying billing entities,” as required by amended claim 1.

Further, Applicants traverse the Examiner’s position that “generating a single billing statement” reads on a “single instance.” Contrary to the Examiner’s assertions, an “instance” is associated with the bill presentment and payment application. Pickering does not teach or suggest an single instance of such an application. Because Pickering, general knowledge of IBPP systems, and Hilt, taken alone or in any reasonable combination, does not teach or suggest all of the restrictions of claim 1, a prima facie case of obviousness has not been established. Accordingly, Applicants respectfully request that the rejection of claim 1 be withdrawn and the claim allowed.

Claims 3 and 5 depend from claim 1. As explained, claim 1 is distinguishable from the cited art. As such, claims 3 and 5 are also distinguishable from the cited art for

at least the same reasons set forth in connection with claim 1. Therefore, Applicants request the rejection of claims 3 and 5 be withdrawn and the claims allowed.

**Regarding New Claims**

Applicants add claims 21-26. Support for these claims may be found at, for example, pages 10-13 of the specification. Because none of the cited art teaches or suggests the recitations of claims 21-26, Applicants request the timely allowance of these claims.

**Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: December 15, 2004

By:   
Wenye Tan  
Reg. No. 55,662